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Docket No.:**382/9-1487**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Applicant:	William T. Evans, et al	Conf. No. 1047	
Serial No.:	10/045,618	Group Art Unit: 3676	
Filed :	October 23, 2001	Examiner:	Christopher J. Boswell
For :	SYSTEM AND METHOD FOR AUTOMATED SELECTION AND DELIVERY OF GIFTS		

Board of Patent Appeals and Interferences
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

This is an appeal by the Applicants from the Final Rejection dated September 15, 2004 of claims 1, 2 and 4-12 of the above-identified application. The appealed claims appear in Appendix A.

REAL PARTY IN INTEREST

The real parties in interest are the inventors, William T. Evans, J. Robert Lemon, Timothy A. Nolan and Robert Christian, and the assignee, Pro-Health, Inc., an Arkansas corporation located at 500 White Drive, Batesville, Arkansas.

RELATED PROCEEDINGS

There are no related appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

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STATUS OF CLAIMS

Claims 1 through 5 were originally in this application. During prosecution, claims 1, 2, 4 and 5 were amended, claim 3 cancelled and new claims 6-12 added. Claims 1, 2 and 4-12 are pending, rejected, and the subject of this appeal.

STATUS OF AMENDMENTS

No amendments were made subsequent to the Final Rejection which issued on September 15, 2004. The pending claims appear in Appendix A.

SUMMARY OF CLAIMED INVENTION

The Applicant's invention is a computer based system and method for the automated delivery of vitamin, minerals, nutritional supplements, and various other formulations as gifts [0002[1]]. The products are referred to collectively as health care products. Such health care products have not been considered appropriate for use as gifts for several reasons. For example, they are packaged and sold for direct consumption. No attention has been given to packaging or presenting such products as gifts. One problem is that there are many health care products to choose from. It would be difficult for an individual to determine what would be appropriate products to send, and how to package them as a gift [0004].

The applicants' system solves these problems. The system comprises a group of health care products consisting of weight management formulations, stress and anxiety relief formulations, mental function formulations, antioxidant formulations, prostate support, joint and bone support, immune system support, anti-aging, general nutritional support, vitamins, minerals; nutritional supplements, digestion, circulation and heart support, and for supporting metabolism[claim 1], means for a user to select a subsets from the group, means for a user to input user and recipient data and for storing the data, means for assembling and packaging the

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1 Reference is to the numbered paragraphs in the published application

gift in a gift package, means for generating a gift card using the data and incorporating the gift card in the gift package, means for generating a thank you acknowledgement using the data, also included in the gift package, and means for sending the gift [0008]. The subsets are product combinations containing from 2-10 products from the group, assembled to suit various individual needs. These may be broken down by age and sex, or by condition, such as addressing aging or cardiovascular health, and to meet the senders' desired price range [0013].

With reference to Figs. 1a and 1b, the user accesses a web site where he reviews the available products. The user has the option to select a particular product subset, or can request a custom combination to send as a gift [0025-0037]. The user inputs sender and recipient information, generating a pre-order for approval. Once approved and payment processed, the order placement is confirmed to the sender. The selected products are collected and assembled with a gift box. A gift card personalized by the sender is prepared and incorporated with the gift card, together with a thank you card that can be used by the recipient. The assembled gift is then sent, and a confirmation given to the sender [0015].

A particular option is to designate a continuing gift. This allows automatically resending the same gift on a selected schedule, so that as the products are consumed, they may be replenished by the gift giver. This can be done automatically, or by way of reminders sent to the sender that the time for reorder is near [0020]. With reference to Fig. 2, a reorder generator is configured at the time the initial order is placed, using the data and selections made by the sender upon order entry, to resend the gift automatically, or to send periodic reminders to the sender that it is time to reorder.

Using the present invention, a new personalized automated delivery system for providing vitamin, nutritional supplements and other health care products as gifts is provided,

presenting a sender with the ability to conveniently select health care products tailored to the recipients' needs.

ISSUES

1. WHETHER CLAIMS 1, 2, AND 4 – 12 ARE OBVIOUS UNDER 35 U.S.C. § 103(a) OVER WEBSITE WWW.GREATCLUBS.COM IN VIEW OF WEBSITE WWW.GNC.COM.

GROUPING OF CLAIMS

The applicant believes the pending claims can be considered in two groupings; Claims 1 and 4 being representative of the basic system and method, Claims 6 and 10 being representative of a second grouping which additionally includes the automatic reminder means for generating periodic reminders, and so the claims are not believed to stand or fall together.

ARGUMENT

I. GREATCLUBS HAS NO SELECTION MEANS

Claims 1, 2 and 4-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over www.greatclubs.com in view of www.gnc.com.

To establish a prima facie case of obviousness based on a combination of the content of various references, there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant. In re Raynes, 7 F.3d 1037, 1039, 28 U.S.P.Q.2D (BNA) 1630, 1631 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2D (BNA) 1443, 1445 (Fed. Cir. 1992). Obviousness can not be established by hindsight combination to produce the claimed invention. In re Gorman, 933 F.2d 982, 986, 18

U.S.P.Q.2D (BNA) 1885, 1888 (Fed. Cir. 1991). As discussed in Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 U.S.P.Q. (BNA) 543, 551 (Fed. Cir. 1985), it is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.

Contrary to the examiner's contention, the Great Clubs website does not disclose the invention substantially as claimed. The applicant's invention is directed to the automated delivery of a selected subset of a group of health care products. Both claim 1 and claim 4 provide for the sender to have means for selecting the subset of healthcare products to be sent as the gift.

Such products were not previously given as gifts, being sold to a user individually for personal consumption. The large variety of possible products and combinations had made it difficult for a sender to even consider such health care products suitable for use as gifts. These are products quite different from, for example, flowers, not normally packaged for presentation as a gift. The applicants system provides subsets of health care products to allow a sender to easily select an appropriate group of products directed to a particular personal need, such as cardiovascular care. Personalization is important, and the present system enables the user to select an appropriate gift tailored to the needs of the recipient, and to have this packaged in a gift box, and sent with a gift card.

As to claims 6 and 10, the system additionally provides means for generating reminders to enable resending the gift selection to the recipient on a user selected programmed basis.

The applicants' system is nothing like the Greatclubs system.Each of the products available from Greatclubs are conventional gifts - beer, wine, flowers, cigars, coffee, pizza and chocolate. Further, Greatclubs is merely a variation of the "Book of the Month" theme. A different product is delivered each and every month. (see ref. pgs.1-2). Greatclubs are based

on a time membership. After you join, products are sent monthly, but the user cannot select what will be sent. There is no capability to select specific products or an individualized shipping schedule. There are no means for selecting a subset of products. The system allows no input from the sender on what product will actually be delivered or when.

Claim 1 specifically requires "means for a sender to select an appropriate subset of the group of healthcare products to be sent to the recipient as a gift." No such means are found at Greatclubs.com, because the Greatclubs system specifically does not permit a user to select specific subsets of the identified product group:

"What will I receive each month?

Each month you receive 2 different bottles of hand-crafted, hard to find wine from around the world."

"Can I choose the wine I receive?

No, all the wines are pre-selected for you. ..." (Emphasis added)

Every fact sheet emphasizes that "No", a user cannot choose what will actually be sent. With such a system, there is no group of products from which one may make a selection. The only option is to join or cancel.

Given this clear description, there is no doubt that the applicants system is structurally different from the Greatclubs' system. Regardless of the product involved, the applicants system enables the user to personally select the appropriate gift, i.e. specific products they deem to be appropriate. There is no monthly obligation to continue to receive products.

Relative to claims 6 and 10, Greatclubs has no means for generating reminders. In fact such reminders would make no sense since products are delivered on a monthly basis; that is the essence of the Great Clubs system. In the applicants invention, frequency of sending further gifts, if any, is set by user input, i.e., if the user wants a reminder in 3 months, or to

automatically resend the gift in 7 months, that is entered in the database, and the system responds according to the users' instructions.

There is no requirement to send any further products. There is the option to have the same gift assortment resent so the recipient does not run out of the product. There is also the option to generate reminders so that the user may consider whether to send another gift. Since Greatclubs has no selection means, there are no means to collect such data, or to use such data as part of a reorder generator, as utilized in the present invention.

II. THERE IS NO TEACHING SUPPORTING THE COMBINATION

The combination proposed by the examiner is a hindsight reconstruction. There is no teaching or motivation to combine found in the gnc.com web site or the Greatclubs website.

The GNC website displays products for individual consumption. A search of the cited pages uncovers no teaching or suggestion for sending these products or subsets of these products as gifts. The cited pages only grouping of items relates to a "buy 2 get one free" offer, totally unrelated to the inventive system.

Many products are available on the internet for purchase for personal use by individual consumers. To simply pick gnc.com as selling health care products and combine it with the Greatclubs site is a typical hindsight reconstruction.

> The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some "teaching, suggestion or reason" to combine cited references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 U.S.P.Q.2D (BNA) 1378, 1383 (Fed. Cir. 1997). When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. See In re Dembiczak, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999), limited on other grounds by In re Gartside, 203 F.3d 1305, 53 U.S.P.Q.2D (BNA) 1769 (2000) (guarding against falling victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher). McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351, 60 U.S.P.Q.2D (BNA)

1001, 1008 (Fed. Cir. 2001).

The examiner offered the following as the motivation to combine these references: "It would have been obvious...to offer vitamins as a gift from the system and method disclosed by Greatclubs in order to contribute to the general health of friends and family...". (Emphasas added) Yet, neither references teaches, suggests or even infers to one skilled in the art such a motivation; the Greatclubs products have nothing to do contributing to good health, being "beer, wine, flowers, pizza, cigars, coffee or chocolate". None of the GNC products are referenced as being appropriate as gifts. To give such products as gifts would itself be unobvious from a review of the GNC site. Giving health care products directed to specific personal needs, such as cardiovascular products, to promote long term health is found only in the applicants invention, not in the prior art.

These products are not suitable for use in a Greatclubs system, sending different products every month. To do so would defeat the purpose of allowing a sender to personally select a subset of appropriate products for delivery. To then send different health care products in the following months makes no sense. Giving different products every month would result in inappropriate or likely useless products being sent to an individual. Thus, the combination is improper, and even if made, would not result in the applicants' invention.

Greatclubs system sends different products every month. It would be contrary to that teaching to change over to a highly personalized gift selection system, and one not based on time membership. The GNC site certainly had nothing to assist a purchaser in selecting and sending any particular subset of health care products as gifts.

Given the distinction in the products, significant sender and recipient input into the selection of gifts, and product based rather than time based resending of gifts, the applicants' invention is readily distinguishable from the cited art.

Relative to claims 6 and 10, there is no teaching or suggestion in either reference for gathering and storing data for generating periodic reminders on the resending of the gifts. As stated above, such reminders have no use in the Greatclubs system. One skilled in the art would be led away from rather than towards use of a reminder generating means.

III. CLAIMS 1, 2 AND 4-12 ARE PATENTABLE

Neither of the references cited by the examiner teaches, suggests, or even hints that health care products could or should be presented as gifts. The Great Clubs website does not disclose the invention substantially as claimed, that is, a system for the automated delivery of a group of health care products, where the user has the freedom to select specific product subsets, including a custom subset if they so desire [0036-37].

The GNC website is not related in any way to a system for the automated delivery of gifts, and there is no teaching or suggestion on either website that such products could or should be used as gifts.

There is nothing to suggest the use of health care products as gifts, nor for use of a system that presents the user with various subsets of such products, previously grouped to be complimentary and appropriate for individual needs, nor for allowing the user to select or create a particular subset. These features are not taught or suggested in the websites cited by the examiner. To arrive at the applicant's invention would require substantial modification of the cited references without any teaching or suggestion to do so.

CONCLUSION

Based on the above, claims 1, 2 and 4-12 are unobvious and reversal of the rejection is respectfully requested.

Dated: April 29, 2005

Respectfully submitted,

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APPENDIX A

1. A system for the automated delivery of gifts comprising a group of health care products, means for a sender to select an appropriate subset of the group of health care products to be sent to the recipient as a gift, means for inputting recipient and sender data and for storing the data, means for assembling and packaging the gift in a gift package, means for generating a gift card using the sender and recipient data and for sending the gift package to the recipient, the health care products selected from the group consisting of weight management formulations; stress and anxiety relief formulations; mental function formulations; antioxidant formulations; prostate support; joint and bone support; immune system support; anti-aging; general nutritional support; vitamins; minerals; nutritional supplements; digestion; circulation and heart support; metabolism; and combinations thereof.

2. The system of claim 1 further comprising means for generating a thank you acknowledgment using the recipient and sender data for incorporating the thank you acknowledged in the gift package.

3. (Cancelled).

4. A method for the automated delivery of gifts, comprising providing a group of health care products selected from the group consisting of weight management formulations; stress and anxiety relief formulations; mental function formulations; antioxidant formulations; prostate support; joint and bone support; immune system support; anti-aging; general nutritional support; vitamins; minerals; nutritional supplements; digestion; circulation and heart support; metabolism; and combinations thereof, providing means for a sender to select an appropriate subset of the group of health care products to be sent to the recipient as a gift, inputting recipient and sender data and storing the data, assembling and packaging the gift in a gift package, generating a gift card using the sender and recipient data and incorporating the gift card in the in the gift package and sending the gift package to the recipient.

5. The method of claim 4 further comprising generating a thank you acknowledgment using the recipient and sender data and incorporating the thank you acknowledgment in the gift package.

6. The system of claim 1 further comprising automatic reminder means for generating periodic reminders and for sending the reminders to the sender to prompt resending of the same gift or sending a different gift to the recipient.

7. The system of claim 1 further comprising automatic resending means for resending the gift to the recipient on a scheduled basis.

8. The system of claim 7 wherein the scheduled basis is selected from the group consisting of monthly, quarterly, biannually and annually.

9. The system of claim 1 further comprising means for assembling and packaging the gift in a gift package.

10. The method of claim 4 further comprising generating periodic reminders and sending the reminders to the user to prompt resending the same gift or sending a different gift to the recipient.

11. The method of claim 4 further comprising resending the gift to the recipient on a scheduled basis.

12. The method of claim 11 wherein the scheduled basis is selected from the group consisting of monthly, quarterly, biannually and annually.